

REMARKS

Applicants and the undersigned are most grateful for the time and effort accorded the instant application by the Examiner.

Upon entry of the present Amendment, Claims 18-25 will be all the claims currently pending for the Examiner's consideration. Claims 1-17 have been canceled. Applicants respectfully submit that no new matter has been added by the present amendments. Support for the amendments can be found generally throughout the Applicants' disclosure.

Applicants also note that the newly added claims encompass the elected invention.

The Office is respectfully requested to reconsider the rejections presented in the outstanding Office Action in light of the following remarks.

I. CLAIM REJECTIONS:

A. 35 USC 112, Second Paragraph

Claims 1-17 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite. In light of the present amendments, the rejections are now moot and can be withdrawn at this juncture.

B. 35 USC 102 and 103

Claims 1-17 were rejected under 35 U.S.C. § 102 and 103 over various references. As indicated above, the previous claims have been canceled and new claims added. Therefore, it is submitted the prior rejections, whether under anticipation or obviousness bases, are no longer applicable to the presently amended claimed invention. Reconsideration of the same is requested.

In hopes of expediting the examination, Applicants would also like this opportunity to note, broadly speaking, some of the shortcomings of the cited art with respect to the instantly claimed invention.

As best understood, Grosman et al., *Southern Journal of Applied Forestry*, 2000 (hereinafter "Grosman") relates to a process for protecting trees against

coneworm and seed bug damage in loblolly pine seed orchards, wherein an insecticide is injected into a living tree by means of high volume pressure injections (STIT). The use of thiamethoxam in low volume injections is mentioned. At minimum, Grosman fails to teach or suggest the tree injection for post felling lumber product protection. Furthermore, Grosman fails to teach or suggest the use of a surfactant and is silent regarding types of solvents used in the insecticide solution.

As best understood, Takai et al., JP 8175914 (hereinafter "Takai") relates to the injection of a living tree with a solubilized formulation comprising an insecticide or germicide, solvent miscible with water, and a surfactant. At minimum, Takai fails to teach or suggest the tree injection for post felling lumber product protection. Furthermore, Takai appears to also fail to teach or suggest the use of the present neonicotinoids, for example, thiamethoxam.

As best understood, Kim et al., Abstract of Journal of Korean For. Soc. (hereinafter "Kim") relates to the injection of a living tree with insecticides, including imidacloprid and thiamethoxam. At minimum, Kim fails to teach or suggest the tree injection for post felling lumber product protection. Furthermore, Kim appears to also fail to teach or suggest the use of a surfactant and is silent regarding types of solvents used in the insecticide solution.

As best understood, Derwent Abstract of Forestry Mech. Res. Inst. (hereinafter "Derwent Abstract") relates to the injection of a living tree with insecticides prior to felling or immediately after felling to increase quality of wood during storage and transport. At minimum, Derwent Abstract fails to teach or suggest the use of the present neonicotinoids, for example, thiamethoxam and while disclosing tree storage and transport, Derwent Abstract is silent regarding tree injection for post felling lumber product protection. Furthermore, Derwent Abstract appears to also fail to teach or suggest the use of a surfactant and is silent regarding types of solvents used in the insecticide solution.

As best understood, Senn, US Pat. Pub. No. 2003/0181448 (hereinafter "Senn") relates to a method for the control of wood pests via application of a

pesticidally active amount of a pesticidal composition to the pests or their habitat. Said pesticidal composition comprises thiamethoxam either alone, or in combination with a surfactant and a solvent. At minimum, Senn fails to teach or suggest any type of tree injection, especially tree injection for post felling lumber product protection.

As best understood, Uto et al., Abstract of WO 2004/108372, (hereinafter "Uto") relates to a method for producing functional wood, wherein an insecticide is injected into a living tree prior to it being cut down and formed into a functional wood. At minimum, the Uto Abstract is silent regarding type of insecticide, whether there is a solvent and surfactant and/or types thereof. In any event, as Examiner rightly noted, Uto can be overcome with Applicants' perfection of its priority claim via submission of certified translation of the priority document. Applicants intent to perfect their priority claim and therefore in the unlikely event Uto continues to be applied as part of a future rejection, Applicants will be prepared to respond accordingly at such time.

For the aforementioned reasons, Applicants respectfully assert that the claims are not anticipated or obvious over the cited references and, therefore, the withdrawal of the rejections is requested.

C. Obvious Type Double Patenting Rejections

Claims 1-17 were previously provisionally rejected based on an obvious type double patenting over Claims 1, 5, 7-10 of co-pending application no. 10/598,616, in further view of allegedly acknowledged prior art and the Derwent Abstract and Senn. Applicants' respectfully submit such is an improper double patenting rejection as it looks beyond the claims of the co-pending application.

It is well established that a double patenting rejection is used to ensure one party does not obtain patent protection in more than one patent for identical or substantially identical (obvious) inventions. A double patenting rejection, therefore, relates to a comparison of the claims of the copending case only, unlike a 103 rejection which can consider all that a reference teaches or suggests (including in combination with other references). Simply put, it is improper to combine the claims

of a copending case with other references so as to make an obvious type double patenting rejection. Thus, the rejections should now be withdrawn.

II. CONCLUSION

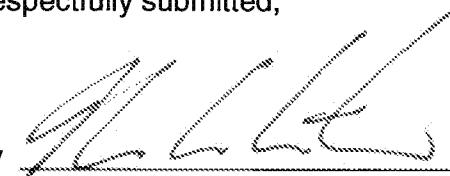
In view of the foregoing, it is respectfully submitted that Claims 18-25 are fully distinguishable over the applied art and are thus in condition for allowance. Notice to the effect is earnestly solicited.

If there are any further issues in this application, the Examiner is invited to contact the undersigned at the telephone number listed below.

The USPTO is hereby authorized to charge any fees, including any fees for an extension of time or those under 37 CFR 1.16 or 1.17, which may be required by this paper, and/or to credit any overpayments to Deposit Account No. 50-2527.

Respectfully submitted,

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